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EXAMINER

ROWAN, KURT C

ART UNIT	PAPER NUMBER
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3643

DATE MAILED: 08/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/526,727	Applicant(s) POLLMANN, WALTER	
	Examiner Kurt Rowan	Art Unit 3643	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>March 3, 2005</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the angular profile forms an angle of less than 90 degrees and the profile strip must be shown on the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

Art Unit: 3643

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims should be rewritten to conform to current US patent practice. The claims are narrative. Claims 6, 7, and 8, 9, 11 and others refer to how items are formed and more properly should be part of method claims. Claim 6 refers to support element 23 and claim 7 refers to a support element 21. It appears that these are meant to be different elements and therefor should have different names or terminology. Clarification is requested. Below are some examples of problems in the claims regarding 35 US 112, second paragraph.

4. Claim 1 recites the limitation "the distance " in line 8. There is insufficient antecedent basis for this limitation in the claim.

5. Claim 1 recites the limitation "the length" in line 9. There is insufficient antecedent basis for this limitation in the claim.

6. Claim 1 recites the limitation " the lower most conductive element " in lines 13-14. There is insufficient antecedent basis for this limitation in the claim.

7. Claim 2 recites the limitation "the sides" in line 2. There is insufficient antecedent basis for this limitation in the claim.

8. Claim 3 recites the limitation "the surface" in line 3. There is insufficient antecedent basis for this limitation in the claim.

9. Claim 5 recites the limitation "the protective element" in lines 1-2. There is insufficient antecedent basis for this limitation in the claim.

10. Claim 11 recites the limitation " the outer edge" in line 3. There is insufficient antecedent basis for this limitation in the claim.

11. Claim 11 recites the limitation "the legs" in line 13. There is insufficient antecedent basis for this limitation in the claim.

12. Claim 11 recites the limitation "the inner sides" in lines 4. There is insufficient antecedent basis for this limitation in the claim.

13. Claim 12 recites the limitation "the barrier device" in line 4. There is insufficient antecedent basis for this limitation in the claim.

14. Claim 26 recites the limitation "the forked section " in line 2. There is insufficient antecedent basis for this limitation in the claim.

15. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 17 recites the

Art Unit: 3643

broad recitation 5 to 50 mm, and the claim also recites a spacing of 10 to 20 mm which is the narrower statement of the range. Also, in another present instance, claim 26 recites the broad recitation 5 degrees to 22 degrees, and the claim also recites approximately 16 degrees which is the narrower statement of the range/limitation.

Claim Rejections - 35 USC § 102

16. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

17. Claims 1-8, 18, 22, 23-25 as can be understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Saunders et al. (US 5,007,196).

The patent to Saunders shows an insect barrier device having a support element 26, 30 made from an eclectically insulating material and at least two conductors 14, 16 arranged in a spaced apart parallel relationship. Also see conductors 114, 116 and supports 26 and 126 in Figs. 15A-15B. Saunders shows a connecting surface 26 that extends upwardly between the conductive elements 114, 116. Saunders shows a protective element 50 as shown in Fig. 6, that forms an intermediate chamber above the conductive elements 13 and the protective element extends at least partially downwardly. Saunders shows the support element formed in the manner of a profile strip 26, for example as shown in Fig. 15A which is attachable to a barrier device such as the exterior foundation 36 of a building 34. In reference to claim 9, Saunders shows

a barrier device 60 in Fig. 6 that is formed in the manner of a square timber. In reference to claim 18, Saunders discloses that the conductors 14, 16 are made from aluminum in column 7, line 68. In reference to claim 22, Saunders shows 4 conductive elements 104, 106 as shown in Fig. 14 which extend parallel to one another along the longitudinal axis of the device. In reference to claim 23, Saunders shows one conductive element connected to one side of the voltage source and the other conductive element connected to the other side of the voltage source which would inherently be of a different polarity than the first side of the voltage source. In reference to claim 24, Saunders shows the conductive elements being formed to be wavy in Figs. 9B, 10B, 11B, and 13.

18. Claims 1-9, 11, 12, 15, 16, as can be understood are rejected under 35 U.S.C. 102(b) as being anticipated by Shanahan et al. (US 4,165,577).

The patent to Shanahan shows an insect barrier device having a support element 310 made from an electrical insulating material and at least two conductive elements 324, 324 such as shown in Fig. 10. The other embodiments such as shown in Figs. 2, 5 and 8 show the same concepts. Shanahan shows that the distance between the conductive elements to be at least minimally smaller than the length of the insects to be driven away. Shanahan shows the conductive elements run vertically offset in different heights and a minimal height difference is provided between the lower most conductive element 324 (the outermost element) and the underlying surface 13. In reference to claims 15, 16, Shanahan shows a coupling device or connector 48 to join adjacent profile strips to form an electrical connection between associated conductive elements

such as shown in Fig. 4. In reference to claim 11, Shanahan shows the inner sides of both legs such as shown in Figs. 2 and 5, come into contact by way of rib 29. Also see Fig. 10 which shows the inner surface of both legs in contact by way of push plate 61, In reference to claim 12, Shanahan shows screws 11 mounting the strip to a support 12 as shown in Fig. 2

Claim Rejections - 35 USC § 103

19. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

20. Claims 9-10, 17, 19-21, 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Saunders et al.

The patent to Saunders shows an insect barrier device as discussed above. In reference to claim 9, Saunders discloses posts 60 in Fig. 6. It is not clear if they can be considered as square posts, but at any rate it would have been obvious to employ square posts. See the citation to In re Leshin, below. In reference to claim 10, Saunders does not show the barrier device extending downwardly into the ground. Saunders shows the barrier device 50 extending downwardly. In reference to claim 10, it would have been obvious to extend the barrier device into the ground since merely the rearrangement of the location of parts is contemplated and the function is the same. See In re Japikse, 86 USPQ 70. In reference to claims 19-20, Saunders discloses a standard 60 cycle 120 volt AC power source or a suitable DC battery does not disclose

Art Unit: 3643

200 to 5000 volts. However, it would have been obvious to employ a higher voltage in the range recited such as 220 volts since the function is the same and no stated problem is solved. In reference to claim 21, Saunders discloses that the supports are made from Mylar/ PVF which can be considered as a thermoplastic, but it would have been obvious to employ PVC since the selection of a known material is based on its suitability for the intended use. See *In re Leshin*, 125 USPQ 416.

21. Claims 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shanahan.

The patent to Shanahan shows an insect barrier device as discussed above. In reference to claim 13, Shanahan in Fig. 10 shows the angle between the legs 27b and 310 as being about 90 degrees. Other embodiments of Shanahan show the legs, where they meet at an angle of about 90 degrees and the legs extend in a more or less parallel relationship with each other. However, it would have been obvious to employ an angle of less than 90 degrees since routine experimentation would be used to determine the optimum angle since the function is the same and no stated problem is solved. In most if not all of the embodiments shown by Shanahan it appears that the legs are at least partly elastically deformable with one another since the plastic used to make the legs tend to deform elastically. Also, it would have been obvious to make the legs elastically deformable with respect to one another to prevent breakage and to allow for irregularities in the undersurface. In reference to claim 14, Shanahan shows a sealing element 66 as the bottom of one of the legs as shown in Fig. 10. It appears that the sealing element 66 is made from plastic but it would have been obvious to

Art Unit: 3643

make the lip from rubber since the function is the same. See the citation to In re Leshin, above.

Conclusion

22. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The patent application publication and patents to Snow, Toyota, Willard, McGill, Djukastein, Black, and Lapierre show other insect barrier devices.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kurt Rowan whose telephone number is (571) 272-6893. The examiner can normally be reached on Monday-Thursday 6:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Poon can be reached on (571) 272-6891. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Application/Control Number: 10/526,727
Art Unit: 3643

Page 10

A handwritten signature in black ink, reading "Kurt Rowan". The signature is stylized with a large, sweeping "K" and a long, horizontal stroke extending from the end of the name.

Kurt Rowan
Primary Examiner
Art Unit 3643

KR